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09/665,790	09/20/2000	Penny H. Baron	6076-0002	6153
21888	7590	01/05/2005	EXAMINER	
THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			DIXON, THOMAS A	
		ART UNIT	PAPER NUMBER	
			3629	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/665,790	Applicant(s) BARON ET AL.
Examiner	Art Unit Thomas A. Dixon	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 27 December 2004.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-60 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 September 2000 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendments / Arguments***

1. Applicant's arguments and amendments have been considered, but are not convincing, the additional text in the whereby/wherein clauses will be given no weight, as they have no weight in apparatus claims as 1 and 21, further as per the methods, Kepecs is seen to disclose the central management claimed.

Applicant's explanation of the support for amendment necessitated the new rejection to the specification / drawings.

Applicant's arguments to the combinability of the references is not convincing as all the references are to couponing art are seen to be combinable no matter where the coupons are printed.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Specification***

3. The disclosure is objected to because of the following informalities:

pg 34, line , the system 10 does not appear in the drawings, however, a network 13 contains the server 22 referred to.

Appropriate correction is required.

***Drawings***

4. The drawings are objected to because of the following informalities:

pg 34 and other pages in the specification refer to the system 10 which does not appear in the drawings, however, a network 13 contains the server 22 referred to as being contained within system 10.

Appropriate correction is required.

***Claim Interpretation***

5. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the

structural limitations of claims 21-52, including maintenance files, a router a transaction log and a server are disclosed by Engel et al in view of Kepecs as described herein.

Also as described the data, whereby and wherein limitations of the claim do not distinguish the claimed apparatus from the prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-42, 44-47, 50-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al (5, 907, 830) in view of Kepecs (6,009,411).

As per Claims 1.

Engel et al discloses:

receiving means for receiving information related to a plurality of offers distributed by a plurality of different distributors to customers for redemption at a plurality of stores, see figure 1 (18);

a router to distribute the one or more distributed offers to one or more point of sale systems, see column 3, lines 6-19;

clearing means for automatically clearing the offers redeemed by the customers, see column 3, lines 6-19.

Engel et al does not disclose central management of offers through an entity different than the stores and offer distributors.

Kepecs teaches central management by a "master store" (23) that is not the store or the offer distributor for the benefit of quick distribution, modification or termination of offers.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a central management of offers and routing means as taught by Kepecs in the invention of Engel et al for the benefit of quick distribution, modification or termination of offers.

As per Claims 2, 13.

Engel et al does not specifically disclose settlement means for automatically reconciling financial obligations associated with each offer cleared by the clearing means, whereby a single electronic audit of each offer transaction can be achieved.

Kepcs teaches a means for automatically reconciling financial obligations, see column 2, lines 45-48 for the benefit of electronically crediting the customer for the offer.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to automatically reconcile the financial obligations for the benefit of electronically crediting the customer for the offer.

As per Claims 3, 14.

Engel et al further discloses means for receiving redemption information from the stores, see column 3, lines 6-19 and

means for comparing the redemption information to the offer information whereby each offer redeemed by the customers can be validated, see column 3, lines 9-11.

As per Claim 4.

Engel et al further discloses the offer distributors comprise at least one of an internet offer distributor, a retail offer distributor, a kiosk offer distributor, a direct mail distributor and an email offer distributor, see column 3, lines 11-19.

As per Claims 5, 15.

Engel et al further discloses means for selectively activating and deactivating each offer, see column 1, lines 46-48.

As per Claims 6, 19.

Engel et al further discloses profiling means for dynamically profiling the customers so that the offers can be targeted to specific customers, see column 9, lines 1-24.

As per Claims 7, 16; 33 .

Engel et al further discloses each offer corresponds to a reward and the system further comprises a reward deferral means for deferring issuance of the reward to a third party, column 2, line 42 – column 3, line 19.

As per Claims 8, 17.

Engel et al further discloses consolidation means for consolidating the offers available through the system for presentation to the customer at a plurality of levels, see figure1 (18) and column 2, lines 48-64.

As per Claims 9, 18.

Engel et al further discloses the plurality of levels comprises at least one of an offer distributor and a store level, see column 2, lines 53-60.

As per Claims 10, 20.

Engel et al further discloses the offer information comprises at least one condition and wherein the at least one condition is at least one of an item purchase condition, a department purchase condition, a total purchase condition, a time of day condition, and a day of week condition, see column 1, lines 11-12.

As per Claim 11.

Engel et al further discloses the profiling means comprises at least one of a static profile, a persistent profile and a dynamic profile, see column 2, line 48 and column 3, lines 11-19.

As per Claims 12, 53.

Engel et al discloses:

receiving means for receiving information related to a plurality of offers distributed by a plurality of different distributors to customers for redemption at a plurality of stores, see figure 1 (18);

a router to distribute the one or more distributed offers to one or more point of sale systems, see column 3, lines 6-19;

clearing means for automatically clearing the offers redeemed by the customers, see column 3, lines 6-19.

Engel et al does not disclose central management of offers through an entity different than the stores and offer distributors.

Kepcs teaches central management by a "master store" (23) that is not the store or the offer distributor for the benefit of quick distribution, modification or termination of offers.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a central management means and routing means as taught by Kepcs in the invention of Engel et al for the benefit of quick distribution, modification or termination of offers.

As per Claim 21.

Engel et al discloses:

one or more maintenance files, each maintenance file including one or more distributed offers, and each distributed offer having at least one offer property, at least one condition and at least one reward, see figure 1 (20);

a router to distribute the one or more distributed offers to one or more point of sale systems, see column 3, lines 6-19;

a server to clear the one or more redeemed offers with the one or more distributed offers, see column 3, lines 6-19.

Kepcs teaches central management by a "master store" (23) that is not the store or the offer distributor for the benefit of quick distribution, modification or termination of offers.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a central management means as taught by

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Kepecs in the invention of Engel et al for the benefit of quick distribution, modification or termination of offers.

As per Claims 22.

Engel et al further discloses the server is operable to receive the one or more distributed offers from one or more distributors, and to create the one or more maintenance files having the one or more distributed offers, see column 3, lines 1-19.

As per Claims 23, 54.

Engel et al further discloses authenticating the distributed offer, see column 3, lines 6-11.

As per claim 24.

Engel et al further discloses a database, see figure 2 (36).

As per Claims 25, 55.

Engel et al further discloses one or more aspects of the database are viewable by a consumer via a browser interface, see figure 2 (32, 26, access via WWW).

As per Claims 26, 56.

Engel et al further discloses the one or more aspects of the database are viewable by a user via kiosk, see figure 2 (32, 26).

As per Claim 27.

Engel et al further discloses the server includes the router, see column 2, lines 42-60.

As per Claim 28.

Engel et al further discloses each distributed offer includes a unique reference code, see figure 1 (24).

As per Claim 29.

Engel et al further discloses each distributed offer includes an identity of the distributor, see figure 1 (24).

As per Claims 30, 60.

Engel et al further discloses the distributed offer is a consumer specific offer, see column 2, lines 42-60.

As per Claims 31, 57.

Engel et al further discloses the server clears the one or more redeemed offers with the one or more distributed offers by being able to prepare one or more settlement details.

Kepecs teaches an automatic settlement system, see column 5, lines 28-39 for the benefit of quick account reconciliation.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include the automatic settlement system of Kepecs for the benefit of quick account reconciliation

As per Claim 32.

Engel et al further discloses at least one reward includes a deferred award, and wherein the server clears the one or more redeemed offers with which the one or more distributed offers by being operable to redeem the deferred reward, see figure 1 (24) and column 3, lines 1-11.

As per Claim 34.

Engel et al does not disclose communication of one or more settlement details to a settlement agent.

Kepecs teaches an automatic settlement system, see column 5, lines 28-39 for the benefit of quick account reconciliation.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include the automatic settlement system of Kepecs for the benefit of quick account reconciliation

As per Claim 35.

Engel et al further discloses the server is operable to accrue data relating to redeemed offers and to profile the accrued data, see column 3, lines 1-19.

As per Claim 36.

Engel et al further discloses the server is operable to communicate the profile to the one or more distributors, see figure 1 and column 3, lines 20-24.

As per Claims 37, 59.

Engel et al further discloses the profiling means comprises at least one of a static profile, a persistent profile and a dynamic profile, see column 2, line 48 and column 3, lines 11-19.

As per Claim 38.

Engel et al further discloses the at least one property includes whether the offer is open to the public, see column 1, lines 11-14.

As per Claim 39.

Engel et al further discloses at least one offer property includes the offer being offered by a vendor or a store, see figure 1 (24).

As per Claim 40.

Engel et al further discloses at least one offer property includes the maximum number of times that the offer may be used by a consumer per transaction, see figure 1 (24).

As per Claim 41.

Engel et al further discloses at least one offer property includes the maximum number of times the offer may be used by a consumer across transactions, see figure 1 (24).

As per Claim 42.

Engel et al further discloses the date and time when the offer becomes active, see column 2, lines 30-38.

As per Claim 44.

Engel et al further discloses a text description of the offer, see figure 1 (24).

As per Claim 45.

Engel et al further discloses a unique number to identify a sponsor of each offer, see figure 1 (24).

As per Claim 46.

Engel et al further discloses whether a reward is to be received in the future, see figure 1 (24).

As per Claim 47.

Engel et al further discloses at least one or more items must be purchased, see figure 1 (24) and column 1, lines 11-12.

As per Claim 50.

Engel et al further discloses one or more days the offer may be redeemed, see column 1, lines 9-12.

As per Claim 51.

Engel et al further discloses an item purchase condition, a department purchase condition, a total purchase condition, a time of day condition, and a day of week condition, see column 1, lines 9-12.

As per Claim 52.

Engel et al further discloses an item discount reward, a department discount award, a total purchase award, a free item award, and a replacement price reward, see column 1, lines 9-12.

As per Claim 58.

Engel et al further discloses accruing data relating to the redeemed offer and profiling the accrued data, see column 3, lines 6-19.

7. Claims 43, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al (5, 907, 830) in view of Scroggie et al (5,970,469).

As per Claim 43.

Engel et al does not specifically disclose the at least one offer includes the date and time when the offer becomes inactive,

Scroggie et al discloses a manufacturer's coupon with and expiration date, see figure 11, for the benefit of limiting the offer by time.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include an expiration date on a coupon to limit the offer by time.

As per Claim 48.

Engel et al does not specifically disclose at least one condition includes one or more departments from which each of the one or more items must be purchased.

Scroggie et al teaches selecting items from departments, see figure 8 (222,224) and generating coupon tie-ins, see figure 10 (252) for the benefit of increased sales and building customer loyalty to the store or brand.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include one or more departments from which each of the one or more items must be purchased for the benefit of increased sales and building customer loyalty to the store or brand.

8. Claim 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al (5, 907, 830) in view of Off et al (5,612,868).

As per Claim 49.

Engel et al does not specifically disclose a minimum purchase amount,

Off et al discloses a minimum purchase amount, see figure 4b (81), for the benefit of increased sales and building customer loyalty to the store or brand.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a minimum purchase amount condition for the benefit of increased sales and building customer loyalty to the store or brand.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Examiner  
Art Unit 3629

January 3, 2005